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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,028	08/17/2000	David L. Multer	FUSN1-01016USO LEV/JAV	4541
28554	7590	10/21/2004	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			MOFIZ, APU M	
			ART UNIT	PAPER NUMBER

2165

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/641,028

Applicant(s)

MULTER ET AL.

Examiner

Apu M Mofiz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06/07/2000</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Bodnar et al. (U.S. Patent No. 6,295,541 and Bodnar hereinafter).

As to claims 1,4,5,7,8,13,14,15 and 16, Bodnar teaches a synchronization method, which comprises providing a first data package (i.e. changes may flow out of the client; the synchronizer data set is then updated by the changes) (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67) having a first transaction including an identification

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number, an action, and a plurality of fields each with an attribute representing change information (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); providing a second data package (i.e. changes from the second client are sent to the synchronizer and both the clients record ID corresponds/mapped to the GUD ID) having a second transaction made subsequent to the first transaction, the second transaction having an identification number, an action, and a field with an attribute (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); determining whether the identification number of the second transaction corresponds to the identification number of the first transaction (i.e. determining if they are both mapped to the same GUD ID) (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); determining whether the field of the second transaction corresponds to one of the fields of the first transaction (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); combining (i.e. synchronizing), when the identification numbers of the first and second transactions correspond to one another and the field of the second transaction corresponds to one of the fields of the first transaction, the first and second data packages to define a combined data package having a combined transaction with the identification number (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); and replacing the second data package with the combined data package (Fig. 2; col 4, lines 1-67; col 5, lines 1-30); and replacing the second data package with the combined data package (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30).

As to claims 2 and 9, Bodnar teaches deleting the first data package (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30).

As to claims 3 and 10, Bodnar teaches determining the type of action of the second transaction (i.e. GUD_Update or GUD_Add or GUD_Delete etc.) (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); defining, when the action of the second transaction is "Add," the combined transaction to include an "Add" action and the corresponding field and the attribute of the second transaction (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); defining when the action of the second transaction is "modify," the combined transaction to include an "add" action and the corresponding field and the attribute of the second transaction; (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30); and defining, when the action of the second transaction is "delete," the combined transaction to include a "delete" action and the corresponding field (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30).

As to claims 11,12,and 17, Bodnar teaches at least a third and a fourth data package files (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30), wherein the first and second data package files included data from a first device (Fig. 2; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col

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42, lines 1-30) having a data store coupled to the network (Fig. 2; Fig. 3A; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30) and the third and fourth data package files include data from a second device having a data store coupled to the network (Fig. 2; Fig. 3A; Fig. 10C; col 4, lines 1-67; col 11, lines 1-67; col 41, lines 45-67; col 42, lines 1-30).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-5 and 7-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,295,541.

Claims 1-5 and 7-17 are merely a obvious variation of claims 1-30 of the '541 patent. E.g., while claims 1 and 8 of the '541 patent is slightly broader than claim 1 of the instant application with respect to the number of datasets (i.e. data packages; two datasets are a subset of arbitrary number of multiple datasets), this difference is not enough to distinguish the two claims, but indicate that it is merely a subset of the '541

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patent. These differences are not sufficient to render the claims patentably distinct, and therefore, claims 1-5 and 7-17 are invalid.


Therefore 37 CFR 1.131 should not apply to this '541 reference.

Points of Contact

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Apu M. Mofiz whose telephone number is (703) 605-4240. The examiner can normally be reached on Monday – Thursday 8:00 A.M. to 4:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached at (703) 3053830. The fax numbers for the group is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.


Apu M. Mofiz
Patent Examiner
Art Unit 2175

October 06, 2004